Hovsepian v. Apple, Inc. Doc. 202

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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION	CASE NO. 05 CV 01114 JW MDL No. 1665 **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S RESPONSE TO THE ROUNDS 1 AND 2 DEFENDANTS' POST-HEARING BRIEF RE THE CONSTRUCTION OF THE TERM "RECEIVING SYSTEM"** **DATE:** N/A **TIME:** N/A **CTRM:** Hon. James Ware

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I. INTRODUCTION

Acacia hereby responds to the Rounds 1 and 2 defendants' supplemental claim construction brief regarding the term "receiving system" of asserted claims 19-22 of the '992 patent and claims 2 and 5 of the '275 patent.

Although the Rounds 1 and 2 defendants contend in their supplemental brief that the term "receiving system" is indefinite, they fail to address Acacia's and the Round 3 defendants' proposed constructions for "receiving system," or even attempt to argue why those constructions would be improper.[1] Acacia's and the Round 3 defendants' constructions for "receiving system," which are the same for each claim in which the term is used and which do not include any of the additional limitations specified in the independent or dependent claims, are legally correct and thus demonstrate beyond all doubt that the term "receiving system" is *not* insolubly ambiguous, and thus is *not* indefinite as a matter of law. This fact is not changed by Acacia's stipulation that the "reception system" in claims 2 and 5 of the '275 patent is located at the head end of a cable television system, as the Rounds 1 and 2 defendants now contend.

Acacia therefore respectfully requests that the Court construe the term "receiving system" in all claims as "as assembly of elements, hardware and software, capable of functioning to receive information."

II. THE TERM "RECEIVING SYSTEM" IS DEFINITE

A. Acacia's and the Round 3 Defendants' Proposed Constructions for "Receiving System"

The constructions of "receiving system" proposed by Acacia and the Round 3 defendants demonstrate that "receiving system" is not insolubly ambiguous and is therefore not indefinite.

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[1] Although the Rounds 1 and 2 defendants ostensibly filed their supplemental brief for the sole purpose of addressing Acacia's stipulation to the Round 3 defendants contention that the "reception system" in claims 2 and 5 are located at the head end of a cable television system, the Rounds 1 and 2 defendants have instead used their supplemental brief, for the most part, to *repeat* their contentions and arguments from their pre-hearing briefs. (*See, e.g.*, 1:12 – 2:27; 4:3 – 5:1; and 5:25 – 6:10). Acacia will not re-address each of the Rounds 1 and 2 defendants' arguments previously made in the briefing, but, instead shall direct the Court to the pertinent pages of Acacia's pre-hearing briefing (Opening Brief, Document No. 145, at 14:1 – 16:11 and Reply Brief, Document No.173, 13:15 – 20-16).

Acacia proposes that the Court construe "receiving system," consistent with the Court's prior construction of "reception system," as "an assembly of elements, hardware and software, capable of functioning together to receive information." Additional limitations to the meaning of the "receiving system" would then be found within the context of each claim in which the term "receiving system" is used.

The Round 3 defendants do not contend that the term "receiving system" is indefinite, but have instead proposed that the Court construe the term "receiving system." This is a very significant fact, because the Round 3 defendants have exactly the same incentive as the Rounds 1 and 2 defendants to have the Court declare the term "receiving system" indefinite. Yet the Round 3 defendants have examined the same claims, have examined the same specification, have examined the same prosecution histories, and have applied the same law as have the Rounds 1 and 2 defendants, *but* the Round 3 defendants have concluded that the term "receiving system" is definite.

The Round 3 defendants even offer a construction for the term "receiving system" that is similar to Acacia's proposed construction: "a system which receives information, either electronically or optically, directly from a transmission system."[2] (*See*, Round 3 Defendants' Proposed Constructions, at 10, a true and correct copy of which is attached as Exhibit 1 to the accompanying Block Decl.). Additionally, the Round 3 defendants, like Acacia, contend that additional limitations to the meaning of "receiving system" would then be found within the context of each claim in which the term "receiving system" is used. (*See*, Joint Claim Chart re the '992 and '275 Patent Terms, Document No. 147, at p. 2).[3]

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[2] Acacia disagrees with the Round 3 defendants' limitations that the information be received "either electronically or optically" or "directly" from a transmission system, as discussed in Acacia's Legal Brief, at 66:25 – 67:26, Document No. 184. These disagreements do not affect the definiteness of the term "receiving system," they merely go to the proper scope of the "receiving system."

[3] In the Joint Claim Chart re the '992 and '275 Patent Terms, Document No. 147, at p. 2, the Round 3 defendants stated that "'Receiving system' in the '992 patent claims, for the present purposes, should be construed to mean the same thing as 'reception system,' a term which the Court has already construed. . . . The construction of 'receiving system' in the '275 patent claims is provided elsewhere in this chart, in the context of the language of those claims." In the context of the '275 patent claims, the Round 3 defendants contended that the receiving system must be a device on which playback can occur. This proposed construction does not change the meaning of "receiving

B. Acacia's and the Round 3 Defendants' Proposed Constructions for "Receiving System" Encompass All of the Features of a "Receiving System" in the Claims

The Rounds 1 and 2 defendants contend that "any definition of 'receiving system' must be capable of encompassing *all* of the features of a 'receiving system' disclosed in *all* of the patents' claims.[4] *Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d 1322, 1327-29 (Fed. Cir. 2006)." (*See*, Supplemental Brief, at 5:25-27). What this means is that the construction of "receiving system" must be the same in all claims in which "receiving system" is used and that the construction must not include any limitations that are contained elsewhere in the independent and dependent claims in which "receiving system" is used.

In *Wilson*, three independent claims were at issue – claims 1, 15, and 18. The term "gap," which described the spatial relationship between a softball bat frame and an insert within the frame, appeared in independent claims 1 and 15 of the patent. In the context of each of these claims, the gap was described differently due to the use of different modifiers in each of these claims. For instance, independent claim 15 included the modifier that the gap be an "annular gap." According to the ordinary meaning of "annular," there can be no contact between the bat frame and the insert. *Wilson Sporting Goods*, 442 F.3d at 1328. Independent claim 1 did not include the same "annular"

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system" in all claims, it merely refers to other language in the '275 patent claims. Acacia disagrees with the Round 3 defendants' construction of "receiving system" in the '275 patent claims. (*See*, Acacia's Reply re the '992 and '275 patent claim terms, Document No. 173, at 59:14-19).

[4] Additionally, at the June 14 hearing and in another portion of their supplemental brief, the Rounds 1 and 2 defendants contend that the construction of 'receiving system" must cover all of the different ways in which the receiving system is used in the *specification*. (*See*, June 14 Transcript, at 201:9-13: "I don't think that there's any definition that the court can craft that covers all of the different ways in which receiving system is used in the specification. . ." and Supplemental Brief, at 6:11-13: "Likewise, the definition of 'receiving system' must be the same in all claims of the '992 and '275 patents, and it must be capable of encompassing *all* of the features that the patents attribute to a 'receiving system.'") Defendants appear to be asking the Court to improperly import all of the limitations from the specification into the construction of "receiving system." *SRI Int'l v. Matsushita Electric Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc) ("If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Nor could an applicant, regardless of the prior art, claim more broadly than that embodiment. Nor would a basis remain for the statutory necessity that an applicant conclude his specification with 'claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.' 35 U.S.C. § 112. It is the claims that measure the invention")

limitation of claim 15; instead, claim 1 stated that the gap had "at least a part of an annular shape." This description of the "gap" in independent claim 1 did not preclude contact between the bat frame and the insert. *Id.*

The district court had construed the term "gap" so as to *preclude* contact between the bat frame and the insert. *Wilson,* 442 F.3d at 1325. The district court's construction of "gap" thus would change of the meaning of claim 1 such that it would include the limitation that there could be no contact between the frame and the insert, even though some contact was possible given that the claim used the modifier "at least a part of an annular shape" rather than requiring an "annular gap." *Wilson Sporting Goods,* 442 F.3d at 1328. Thus, the Federal Circuit construed the term "gap" in all claims to mean "a separation." *Id.*, at 1329. This construction therefore would encompass "gaps" in which contact was precluded (an annular gap of claim 15) and would encompass "gaps" in which some contact was permissible (a gap having at least part of an annular shape of claim 1).

In *Wilson Sporting Goods,* the Federal Circuit also discussed the errors in the district court's construction of the claim term "insert." The district construed the term "insert" to include the limitations of being both "hollow" and "rigid." With respect to "hollow," the Federal Circuit held that: (1) the claim did not require a hollow insert and the court would not read that limitation into the claim from the specification, and (2) "insert" can be defined broadly enough to encompass both a hollow and a solid insert, and have the same meaning in all claims:

> The trial court also interpreted the insert as hollow. Only claim 15, however, requires a hollow insert, and then, only implicitly. Claim 15 calls for "a hollow bat." Because the insert is part of the internal structure of the bat, the insert must be hollow for the bat itself to be hollow. The preferred embodiment shown in the specification has a hollow insert to minimize "the machining and cold working problems associated with titanium." '398 patent, col 4, I. 68 - col. 5, I. 2. This court, however, declines to read a limitation from the written description into the claims. *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc*., 242 F.3d 1337, 1340 (Fed. Cir. 2001). Here, the context in which "bat" is used in claim 15 is instructive as to the nature of the insert required for that claim. However, "insert" can be defined broadly enough to encompass both a hollow and a solid insert, and yet have the same meaning in all claims.

Wilson Sporting Goods, 442 F.3d at 1329.

With respect to "rigid," the term "rigid" only appeared in a dependent claim. Thus, the

Federal Circuit held that a limitation that the term "insert" in all claims must be "rigid" would be improper:

> The term "rigid" appears in connection with "insert" only once. The term appears that single time in uncontested claim 3, "wherein the insert is rigid." This single use of the term "rigid" does not, however, import a "rigid" limitation into all other claims. Rather it implies that the term "insert," when used elsewhere in the patent, does not inherently carry a "rigid" limitation. *See Phillips*, 415 F.3d at 1314 ("The claim in this case refers to 'steel' baffles, which strongly implies that the term 'baffles' does not inherently mean objects made of steel.")

Wilson Sporting Goods, 442 F.3d at 1329.

1. Acacia's and the Round 3 Defendants' Proposed Constructions for "Receiving System" Are Consistent with the use of "Receiving System" in the Independent Claims

Acacia's and the Round 3 defendants' constructions for "receiving system" are consistent with the holdings in *Wilson Sporting Goods*, because, in both Acacia's and the Round 3 defendants' proposed constructions, the construction of "receiving system" is the same in all claims and the construction of "receiving system" does not include any limitations that are contained elsewhere in the independent and dependent claims.

For example, Acacia's and the Round 3 defendants' constructions for "receiving system" do not state where the "receiving system" is located, i.e., whether it is located at the head end of a cable television system or at the selected remote location, nor should it. This is because the claims themselves specify the location of the "receiving system," using other claim language. Thus, claim 19 of the '992 patent specifies by its own terms that the "receiving system" is located at the selected remote location; this limitation is present, not because it is part of the construction of "receiving system," but because it is explicit in the terms of the claim: "sending a request . . . to the one of the receiving systems at one of the remote locations selected by the user. . ."

Similarly, claim 19 of the '992 patent states that the receiving system stores a complete copy of the received information. Again, neither Acacia's nor the Round 3 defendants' constructions of "receiving system" include the limitation that the "receiving system" stores a complete copy of the information, or even include any limitation regarding whether the "receiving system" stores any information. This is important, because in claims 2 and 5 of the '275 patent, there is no requirement that the “receiving system” store any information, and therefore Acacia’s and the Round 3 defendants’ constructions for “receiving system” is consistent with claims 2 and 5 as well.

2. Acacia’s and the Round 3 Defendants’ Proposed Constructions for “Receiving System” Are Consistent with the Dependent Claims

Acacia’s and the Round 3 defendants’ constructions for “receiving system” are broad enough to encompass the “receiving systems” of the independent and dependent claims in which the term is used and thus comply with the holdings of *Wilson Sporting Goods.*

The Rounds 1 and 2 defendants place all of their emphasis on dependent claims 23, 24, and 49-52 of the ‘992 patent. In their supplemental brief, the Rounds 1 and 2 defendants contend that Acacia withdrew these claims so that the Court would not consider them in construing “receiving system” and go so far as to contend, without any support, that Acacia is attempting to eliminate portions of the patent for claim construction by withdrawing the claims from the patent. *Acacia has never contended nor does it contend now that the Court cannot consider claims 23, 24, and 49-52 of the ‘992 patent when construing “receiving system.”* Instead, Acacia has always contended that the presence of these dependent claims does not render the term “receiving system” indefinite. (*See,* Acacia’s Reply Brief re ‘992 and ‘275 patent terms, Document No. 173, at 14:4 – 17:8; June 14 Transcript, at 217:22 – 218:16).

Dependent claims 23, 24, and 49-52 do not render the term “receiving system” indefinite. The meaning of “receiving system” in all independent and dependent claims (19, 23, 47, and 49-53) is the same – “an assembly of elements, software and hardware, capable of functioning together to receive information.” Acacia does not agree with the Rounds 1 and 2 defendants that dependent claims 23 and 49 require that the “receiving system” be at two locations – the remote location and the head end of a cable television system. (*See,* Acacia’s Reply Brief re ‘992 and ‘275 patent terms, Document No. 173, at 15:18 – 16:17). However, even if these claims included these requirements, Acacia’s and the Round 3 defendants’ construction of “receiving system” is consistent with these dependent claims, because the construction of “receiving system” does not include a limitation on the location of the “receiving system,” i.e., nothing in the construction of “receiving system” precludes the “receiving system” from being located at the selected remote location (as stated in claim 19) and being located at the head end of a cable television reception system (as the Rounds 1 and 2 defendants contend in claim 23).[5]

Interestingly, if one were to look at the patent-at-issue in *Wilson*, U.S. Patent No. 5,415,398, they would see that the "gap" is further defined in the dependent claims of that patent. For example, dependent claim 3 states that "that gap is filled with a lubricant to facilitate the relative movement between the insert and the tubular frame when a ball is struck." (*See,* U.S. Patent No. 5,415,398, attached as Exhibit 2 to the accompanying Block Decl.). Dependent claim 6 states that "the gap thickness is small relative to the thickness of the impact portion wall and the insert wall." *Id.* Dependent claim 16 states that "the gap is filled with a plastic deformable substance." *Id.*

The Federal Circuit did not discuss these dependent claims, because it did not need to; the Federal Circuit's construction of "gap" as "a separation" did not include any limitations regarding whether any material of any kind was included in the gap and did not include any limitations relating to the thickness of the gap. The Federal Circuit's definition of "gap" was therefore broader than the dependant claims and therefore was correct as a matter of law. The same is true of Acacia's and the Round 3 defendants' construction for "receiving system," which, like the court's construction for "gap" in *Wilson*, does not include any of the limitations of the dependent claims.

C. Acacia's and the Round 3 Defendants' Proposed Constructions for "Receiving System" Are Consistent with Claims 2 and 5 of the '275 Patent

Claims 2 and 5 of the '275 patent refer to both a "reception system" and to a "receiving system." Consistent with the patent law rule that the same terms appearing in different claims should have the same meaning (*Wilson*, 442 F.3d at 1328), Acacia and the Round 3 defendants construe the term "receiving system" to have the same meaning in claims 2 and 5 of the '275 patent as in the claims of the '992 patent (claims 19-24 and 47-52). Acacia and the Round 3 defendants also both construe the term "reception system" the same as "receiving system" in all of the claims of the patents. (*See,* Round 3 Defendants' Proposed Constructions, at 10, a true and correct copy of which is attached as Exhibit 1 to the accompanying Block Decl.).

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[5] Including such a limitation in the construction of "receiving system" would be contrary to the doctrine of claim differentiation. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) ("the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim."), *citing*, *Leibel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004).

The fact that Acacia and the Round 3 defendants construe the terms "receiving system" and "reception system" in the same manner does not render the term "receiving system" indefinite. Different terms may have the same construction. *See, e.g., Tate Access Floors, Inc. v. Maxcess Techs., Inc.*, 222 F.3d 958, 968 (Fed. Cir. 2000) ("We agree with Maxcess that the term 'inner layer' in claim 8 should be construed in the same manner as the 'inner body portion' in claim 1 because they are used interchangeably in the specification.")

Even though the terms "receiving system" and "reception system" have the same meaning in claims 2 and 5, the context of these claims makes clear that the "reception system" and the "receiving system" are located in different places and perform different functions, making both of these terms in claims 2 and 5 definite. For instance, claim 2 of the '275 patent states that, in addition to receiving information, the reception system receives information sent from the transmission system, stores a complete copy of the received information, and plays back the stored copy of the information to the receiving system. Further, pursuant to the statements made by the patentees during prosecution of the '275 patent, the reception system is located at the head end of a cable television system.

The "receiving system" of claim 2 includes none of these limitations. Claim 2 of the '275 patent states only that the "receiving system" receives played back information from the reception system. The "reception system" of claim 2 does not include this limitation. Further, claim 2 of the '275 patent requires that the "receiving system" is located at the selected remote location, not at the head end of the cable television system.

The same is true of claim 5 of the '275 patent. In claim 5, the "reception system" is located at the head end of a cable television system and it receives information sent from the transmission system, stores a complete copy of the received information, and plays back the stored copy of the information to the receiving system over a cable communication path. The "receiving system" receives played back information from the "reception system" and is located at the selected remote location, not at the head end of the cable television system.

Although the Rounds 1 and 2 defendants contend that the term “receiving system” is indefinite, they contend that the similar term “reception system” is definite and has the construction given to it by the Court in Markman I.

D. Acacia’s Stipulation to the Round 3 Defendants’ Contention that the “Reception System” of Claims 2 and 5 is Located at a Head End Did Not Change the Definition of “Receiving System”

At the start of the June 15 hearing, Acacia announced that it would be agreeing to a number of the defendants’ proposed constructions in order to streamline the proceedings and to eliminate disputes. (June 15 Transcript, at 5:5:4 – 6:25). Included within these agreements was Acacia’s stipulation to the Round 3 defendants’ contention that the “reception system” in claims 2 and 5 of the ‘275 patent are located at the head end of a cable television system. Acacia did *not* present any argument at the June 15 hearing that this stipulation affected the meaning of “receiving system.”

The Rounds 1 and 2 defendants attribute all sorts of ulterior motives to Acacia’s stipulation, including calling Acacia’s stipulation a “last-ditch effort to bestow some meaning on ‘receiving system’” and arguing that Acacia’s stipulation “further demonstrates that ‘receiving system’ is indefinite.” As demonstrated above, Acacia does not need this stipulation to bestow meaning on “receiving system.”

Other than its pejorative statements regarding Acacia’s motives for its stipulation, the Rounds 1 and 2 defendants offer very little substance in the way of explaining why Acacia’s stipulation further demonstrates that “receiving system” is indefinite. For instance, the Rounds 1 and 2 defendants discuss claim 3 of the ‘275 patent and contend that Acacia’s stipulation “worsens the contradictions surrounding the term ‘receiving system.” The Rounds 1 and 2 defendants further contend that “Acacia’s stipulation would have them [the reception system and the receiving system] be the same or co-extensive.” Claim 3 recites a “receiving system” located at the head end of a cable television system and does not refer to a “reception system.” Acacia’s stipulation regarding claims 2 and 5 and the location of the “reception system” has no effect on the meaning of “receiving system.” “Receiving system” in claim 3 has the same meaning that it has in all of the other claims –

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"an assembly of elements, hardware and software, capable of functioning together to receive information." In the context of claim 3, however, the "receiving system" receives information from the transmission system, stores the information, decompresses the information, and plays back the decompressed data to a user receiver.

The Rounds 1 and 2 defendants further contend that Acacia's stipulation has "changed the *definition* of a reception system." (Supplemental Brief, at 7:9-10). Acacia has not changed the definition of a "reception system." The stipulation merely added further context to claims 2 and 5 of the '275 patent by specifying that, in claims 2 and 5, the "reception system," as that term was previously defined by the Court, is located at the head end of a cable television system.

E. The Rounds 1 and 2 Defendants Have Not Met Their Heavy Burden of Proving Indefiniteness of the term "Receiving System"

The Rounds 1 and 2 defendants have not established that Acacia's and the Round 3 defendants' proposed constructions for "receiving system" are improper. Acacia's and the Round 3 defendants' construction properly give the term "receiving system" the same meaning in all claims and is broad enough to exclude the limitations which are already contained in the claims which use the term "receiving system." Thus, the meaning of the term "receiving system" is discernible and therefore is not indefinite as a matter of law. As the Federal Circuit stated in the *Exxon* case, the Court must be cautious when considering indefiniteness in order to accord respect to the statutory presumption of patent validity:

> In determining whether that standard is met, i.e., whether "the claims at issue [are] sufficiently precise to permit a potential competitor to determine whether or not he is infringing," *Morton Int'l, Inc. v. Cardinal Chem. Co*., 5 F.3d 1464, 1470, 28 U.S.P.Q.2D (BNA) 1190, 1195 (Fed. Cir. 1993), we have not held that a claim is indefinite merely because it poses a difficult issue of claim construction. We engage in claim construction every day, and cases frequently present close questions of claim construction on which expert witnesses, trial courts, and even the judges of this court may disagree. Under a broad concept of indefiniteness, all but the clearest claim construction issues could be regarded as giving rise to invalidating indefiniteness in the claims at issue. But we have not adopted that approach to the law of indefiniteness. We have not insisted that claims be plain on their face in order to avoid condemnation for indefiniteness; rather, what we have asked is that the claims be amenable to construction, however difficult that task may be. If a claim is insolubly ambiguous, and no narrowing construction can properly be adopted, we have held the claim indefinite. If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which

> reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds. [citations omitted]. By finding claims indefinite only if reasonable efforts at claim construction prove futile, we accord respect to the statutory presumption of patent validity, *see N. Am. Vaccine, Inc. v. Am. Cyanamid Co.*, 7 F.3d 1571, 1579, 28 U.S.P.Q.2D (BNA) 1333, 1339 (Fed. Cir. 1993), and we protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal.

Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 1375 (Fed. Cir. 2001).

III. CONCLUSION

For the foregoing reasons, and for the reasons provided by Acacia in its legal briefs and at the June 14 Markman hearing, the Court should construe the term "receiving system" to mean "an assembly of elements, hardware and software, capable of functioning together to receive information."

DATED: August 14, 2006

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